

**REMARKS**

Reconsideration is requested.

Claims 1-7 are pending. Support for the new claim 7 may be found, for example, in the description of Examples 1-4 of the specification. Two polycarbonates can further afford the hardness and flexibility to the charge transporting layer even if a quantity of charge transporting substance is mixed in the charge transporting layer. No new matter has been added.

The Section 103 rejection of claims 1-6 over Obata (U.S. Patent Application Publication No. 2004/0101770) and Nakata (U.S. Patent Application Publication No. 2002/0119382), is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

Obata is based on an application filed in the U.S. on September 3, 2003 and is believed to be only citable as a reference under 35 USC § 102(e)(1). The present application claims benefit to Japan 2003-349644 filed October 8, 2003. The applicants note that the subject matter of the cited Obata application and the presently claimed invention were, at the time the claimed invention was made, owned by the same entity or subject to an obligation of assignment to the same entity. Withdrawal of the Section 103 rejection of claims 1-6 over Obata in view of Nakata therefore is requested.

The Section 103 rejection of claims 1 and 3-5 over JP 2002-365820 and Nakata (U.S. Patent Application Publication No. 2002/0119382), is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

The Examiner is urged to appreciate that the present charge transporting substance of the presently claimed invention requires that  $\text{Ar}^3$  of the compound of the general formula (1) be a heterocyclic group which may have a substituent when "n" is zero. The corresponding structure of the cited JP 2002-365820 (i.e.,  $\text{R}_4$  of formula (1)) however is an aryl. See page "4 of 17", line 8 after the formula of the machine translation supplied by the Examiner (" $\text{R}_4$   $\text{R}_3$ , The aryl group"). All of the compounds 1-1 to 1-10 exemplified on page "7 of 17" of the machine translation of JP 2002-365820 include an aryl for  $\text{R}_4$ . There is no suggestion in the cited art to substitute a heterocyclic group of the present claims for the aryl of the cited art in formula (1) of the cited art to make a charge transporting substance according to the present claims.

Moreover, the applicants believe that according to the Examples of the primary reference, the outer surface layer is not hard such as cured phenol resin because the layers comprise of the non-curable resin. Further though the layer of Nakata containing a charge transporting substance is two layers, the layer of the primary reference containing the charge transporting substance is one layer. Therefore since the layer containing the charge transporting substance of Nakata is different from that of the primary reference in hardness and the number of the layer, Nakata would not have been combined with the primary reference to make the claimed invention in the absence of an impermissible use of hindsight.

Further, Nakata teaches the importance of specific charge transporting compounds with the specific curable phenolic resin described therein. See ¶[0039] for example of Nakata. The combination of a charge transporting substance of JP 2002-

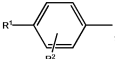
365820 therefore for a charge transporting compound of Nakata would not have been obvious as the same would have been contrary to Nakata.

The most outer surface layer of a photosensitive layer of Nakata is a protective layer. The protective layer contains a curable phenol resin and a charge transporting substance having a hydroxyl group. The most outer surface layer is very hard layer because the hard phenol resin is further cured. Such a very hard layer would never have a flexibility with a creep value of 2.70 to 5.00%. That is to say, the most outer surface layer of the cured phenol resin could not satisfy both a plastic deformation hardness of 220 to 275 N/mm<sup>2</sup> and a creep value of 2.70 to 5.00% simultaneously.

The presently claimed invention would not have been obvious from the combination of JP 2002-365820 and Nakata. Withdrawal of the Section 103 rejection is requested.

The Section 103 rejection of claims 1 and 3-5 over JP 06-043674 in view of Nakata (U.S. Patent Application Publication No. 2002/0119382), is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

The Examiner is urged to appreciate that the present charge transporting substance of the presently claimed invention requires that Ar<sup>3</sup> of the compound of the general formula (1) be a heterocyclic group which may have a substituent when "n" is

zero. The corresponding structure of the cited JP 06-043674 (i.e., ,

on page "3 of 30" of the machine translation provided by the Examiner) however is an aryl. There is no suggestion in the cited art to substitute a heterocyclic group of the present claims for the aryl of the cited art in formula (I) of the cited art to make a charge transporting substance according to the present claims.

Moreover, the applicants believe that according to the Examples of the primary reference, the outer surface layer is not hard such as cured phenol resin because the layers comprise of the non-curable resin. Further though the layer of Nakata containing a charge transporting substance is two layers, the layer of the primary reference containing the charge transporting substance is one layer. Therefore since the layer containing the charge transporting substance of Nakata is different from that of the primary reference in hardness and the number of the layer, Nakata would not have been combined with the primary reference to make the claimed invention in the absence of an impermissible use of hindsight.

The most outer surface layer of a photosensitive layer of Nakata is a protective layer. The protective layer contains a curable phenol resin and a charge transporting substance having a hydroxyl group. The most outer surface layer is very hard layer because the hard phenol resin is further cured. Such a very hard layer would never have a flexibility with a creep value of 2.70 to 5.00%. That is to say, the most outer surface layer of the cured phenol resin could not satisfy both a plastic deformation hardness of 220 to 275 N/mm<sup>2</sup> and a creep value of 2.70 to 5.00% simultaneously.

Further, Nakata teaches the importance of specific charge transporting compounds with the specific curable phenolic resin described therein. See ¶[0039] for

example of Nakata. The combination of a charge transporting substance of JP 06-043674 therefore for a charge transporting compound of Nakata would not have been obvious as the same would have been contrary to Nakata.

The presently claimed invention would not have been obvious from the combination of JP 06-043674 and Nakata. Withdrawal of the Section 103 rejection is requested.

The Section 103 rejection of claims 1-6 over JP 2003-012619 in view of Nakata (U.S. Patent Application Publication No. 2002/0119382), is traversed. Reconsideration and withdrawal of the rejection are requested in view of the following distinguishing comments.

The Examiner is urged to appreciate that the enamine compounds of the general formula (1) of the cited JP 2003-012619 require substituents Ar<sup>1</sup> and Ar<sup>2</sup> bridged by a group "Z". The enamines of the cited art therefore do not include separate Ar<sup>1</sup> and Ar<sup>2</sup> substituents of the presently claimed invention. Moreover, there is no suggestion in the cited art to have made the enamines of the present claims.

Moreover, the applicants believe that according to the Examples of the primary reference, the outer surface layer is not hard such as cured phenol resin because the layers comprise of the non-curable resin. Further though the layer of Nakata containing a charge transporting substance is two layers, the layer of the primary reference containing the charge transporting substance is one layer. Therefore since the layer containing the charge transporting substance of Nakata is different from that of the primary reference in hardness and the number of the layer, Nakata would not have

been combined with the primary reference to make the claimed invention in the absence of an impermissible use of hindsight.

Further, Nakata teaches the importance of specific charge transporting compounds with the specific curable phenolic resin described therein. See ¶[0039] for example of Nakata. The combination of a charge transporting substance of JP 2003-012619 therefore for a charge transporting compound of Nakata would not have been obvious as the same would have been contrary to Nakata.

The most outer surface layer of a photosensitive layer of Nakata is a protective layer. The protective layer contains a curable phenol resin and a charge transporting substance having a hydroxyl group. The most outer surface layer is very hard layer because the hard phenol resin is further cured. Such a very hard layer would never have a flexibility with a creep value of 2.70 to 5.00%. That is to say, the most outer surface layer of the cured phenol resin could not satisfy both a plastic deformation hardness of 220 to 275 N/mm<sup>2</sup> and a creep value of 2.70 to 5.00% simultaneously.

The presently claimed invention would not have been obvious from the combination of JP 2003-012619 and Nakata. Withdrawal of the Section 103 rejection is requested.

The Section 103 rejection of claim 6 over JP 2002-365820 in view of Nakata (U.S. Patent Application Publication No. 2002/0119382) and Diamond (Handbook of Imaging Materials, Marcell Dekker, NY, NY, 1991, pp 160-62), is traversed. Claim 6 is dependent from claim 1. Reconsideration and withdrawal of the rejection of claim 6 are as the deficiencies of the combination of JP 2002-365820 and Nakata are not cured by

the deficiencies of Diamond. Withdrawal of the Section 103 rejection of claim 6 is requested.

The Section 103 rejection of claim 6 over JP 06-043674 in view of Nakata (U.S. Patent Application Publication No. 2002/0119382) in view of Diamond, is traversed. Claim 6 is dependent from claim 1. Reconsideration and withdrawal of the rejection of claim 6 are as the deficiencies of the combination of JP 06-043674 and Nakata are not cured by the deficiencies of Diamond.

The provisional obviousness-type double patenting rejection of claims 1-6 over claims 1 and 3 of copending Application No. 10/550,888 "in view of" Obata (U.S. Patent Application Publication No. 2004/0101770) and Nakata (U.S. Patent Application Publication No. 2002/0119382) is obviated by the attached Terminal Disclaimer. Entry of the attached Terminal Disclaimer and withdrawal of the provisional rejection are requested. The Examiner is requested to appreciate that the cited application issued as U.S. Patent No. 7,302,210 on November 27, 2007.

The provisional obviousness-type double patenting rejection of claims 1-6 over claims 1 and 4-6 of copending Application No. 11/198,405 "in view of" Obata (U.S. Patent Application Publication No. 2004/0101770) and Nakata (U.S. Patent Application Publication No. 2002/0119382) is obviated by the attached Terminal Disclaimer. Entry of the attached Terminal Disclaimer and withdrawal of the provisional rejection are requested.

KIHARA et al  
Appl. No. 10/575,097  
Atty. Ref.: 1114-232  
Amendment  
November 24, 2008

The claims are submitted to be in condition for allowance and a Notice to that effect is requested. The Examiner is requested to contact the undersigned if anything further is required.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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